



Docket No.: 251002009400
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Eiko SEKI et al.

Application No.: 09/994,573

Filed: November 26, 2001

For: METHODS FOR PRODUCING PROTEIN
DOMAINS AND ANALYZING THREE
DIMENSIONAL STRUCTURES OF
PROTEINS USING SAID DOMAINS

Art Unit: 1653

Examiner: Hope A. Robinson, M.S.

DECLARATION UNDER 37 C.F.R. § 1.131

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

We, Eiko Seki, Takanori Kigawa and Shigeyuki Yokoyama, declare as follows:

1. We are the inventors of the subject matter claimed in the above-identified application.
2. We have read and understand the present application and the Office Action including the references cited therein. We understand that a paper, Kawasaki, M., *et al.*, *Biochem. Biophys. Res. Com.* (2001) 280:842-844 has been cited as the basis for rejection of at least some of our claims.
3. We made the claimed invention, directed to a method for producing soluble proteins or protein domains, and reduced it to practice in Japan prior to 25 December 2000. We understand the actual publication date of Kawasaki, *et al.*, to be 26 January 2001 and note that the paper was received 25 December 2000. The exhibits to this Declaration constitute evidence that reduction to practice occurred prior to 25 December 2000.

4. A description of the results of this reduction to practice was presented as a poster session at the 23rd Annual Meeting of the Molecular Biology Society of Japan, the proceedings of which were published on 25 November 2000. The meeting itself was held from 13 December to 16 December 2000.

5. Exhibit 1 is a copy of, and an English translation of, the certificate by the presidents of the Molecular Biology Society of Japan to show our presentation at the 23rd Annual Meeting of the Molecular Biology Society of Japan is the same as the invention of Japanese Patent Application No. 2001-62703. The patent application is a counterpart of the present U.S. Patent Application, and was filed in the Japanese Patent Office on March 6, 2001. The original certificate was filed in the Japanese Patent Office on March 23, 2001. (In order to have a benefit of exceptions to lack of novelty of invention according to the Japanese patent law, we submitted this document to the Director-General of the Patent Office proving that the invention claimed in the patent application is an invention disclosed by the inventors within six months before the filing date.) As shown in page 1 of the certificate, the date of the presentation at the meeting is prior to 16 December 2000. On page 2, the date of publication of the program and abstract of the meeting are shown. The title of each presentation is shown on page 3 and the abstract is shown on page 4.

All of these documents are combined and the stamps of the presidents of the Molecular Biology Society of Japan are sealed on page 1 of the certificate, which indicated the documents were true.

6. Exhibit 2 is a copy of the presentation at the poster session of the meeting. An English abstract is included. Although the poster itself is in Japanese, figures and data of the poster clearly show that the present invention was completed at the date of the meeting.

7. Exhibit 3 is our declaration as inventors of the present application, indicating that the invention described in Exhibits 1 and 2 was made by ourselves and that the co-authors of the poster and abstract worked under our direction.

8. Exhibit 4 is a declaration by our co-authors, Natsuko Matsuda and Yoshihide Hayashizaki, acknowledging that their work consisted only of experimental collaboration with us and thus they are properly not included as co-inventors.

We declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Executed at Yokohama, Japan, on 13 December 2004.
(city) (state or country) (day) (month)

Eiko Seki

(Eiko Seki)

Executed at Yokohama, Japan, on 13 December 2004.
(city) (state or country) (day) (month)

Takanori Kigawa

(Takanori Kigawa)

Executed at Yokohama, Japan, on 13 Dec. 2004.
(city) (state or country) (day) (month)

Shigeyuki Yokoyama

(Shigeyuki Yokoyama)